

## **REMARKS**

### **The Amendments**

Claim 1 is amended to contain a more specific literal recitation of the at least one metal powder and/or semimetal powder as containing a mixture of silicon/aluminum or boron/aluminum in order to distinguish the cited prior art. Support for the amendment is found at page 3, lines 5-6, of the specification, for example. Claims 2 and 7, which were indicated in the Office Action to be allowable if rewritten in independent form, are so rewritten. The further amendments conform the dependent claims to these amendments and add additional similar dependent claims from the new independent claims.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

### **Claims Analysis**

Applicants wish to make a clarifying statement regarding the "Claims Analysis" section of the Office Action on page 3. The Office Action states that the claims require metal powder and/or semimetal powder and special effect pigment. It is also evident that the claims recite a thermoplastic in which these dopant materials are contained.

**The Restriction Requirement**

Applicants respectfully acknowledge the indication in the Office Action that the restricted dependent method claims would be rejoined with the composition claims upon a finding of allowability of the composition claims. As discussed below, it is believed that the composition claims are in condition for allowance, thus, such rejoinder is requested.

**The Rejection Under 35 U.S.C. § 102**

The rejection of claims 1, 3-5, 8, 10 and 14 under 35 U.S.C. § 102, as being anticipated by Hawrylko (U.S. Patent No. 5,496,630) is respectfully traversed.

Hawrylko discloses articles extruded from a mixture of a thermoplastic polyvinyl chloride (PVC), with powdered aluminum metal and a pearlescent pigment.

There is no disclosure in Hawrylko of a composition with contains a thermoplastic, a metal powder and/or semimetal powder which comprises a mixture of silicon/aluminum or boron/aluminum and a special effect pigment. There is no disclosure in Hawrylko to mix the aluminum powder therein with silicon or boron powder. Thus, Hawrylko cannot anticipate instant claim 1 or the claims dependent thereon.

As to claims 2 and 7 and claims dependent thereon, these claims were not subject to the rejection and were indicated to be allowable if rewritten in independent form. Hawrylko does not disclose the aspects of these claims and, thus, also fails to anticipate them.

Hawrylko also fails to disclose that its materials are laser markable. Although the issue of whether the materials are inherently markable is a consideration, inherency in the patent law is generally defined as a phenomena which **necessarily and inevitably occurs**, as opposed to a phenomena which might occur, from a given set of conditions. Ex Parte Cyba, 155 USPQ 756 (Bd. App. 1966); and In re Oelrich, 212 USPQ 323, 326 (CCPA 1981). While the components in the Hawrylko compositions are similar to applicants', they are not

of identical nature and scope. Further, the distinct use of the Hawrylko materials gives no hint that they would or would be desired to be laser markable. Accordingly, applicants urge that laser markability is not a **necessary and inevitable** property of the Hawrylko materials.

For the above reasons, the rejection under 35 U.S.C. § 102 should be withdrawn.

#### **The Rejection Under 35 U.S.C. § 103**

The rejection of claim 6 under 35 U.S.C. § 103, as being obvious over Hawrylko in view of Linzmeier (U.S. Patent No. 6,521,688) is respectfully traversed.

Hawrylko is discussed above and that discussion is incorporated herein by reference. As discussed, Hawrylko fails to disclose compositions having a metal powder and/or semimetal powder which comprises a mixture of silicon/aluminum or boron/aluminum. The disclosure and background discussion of Hawrylko make clear that Hawrylko is specific to the use only of aluminum as a metal powder. Apparently, the decorative effect sought by Hawrylko requires the use, solely, of aluminum powder as a metal powder. There is no suggestion in Hawrylko to use other metal or semimetal powder in admixture with aluminum powder. To the contrary, one of ordinary skill in the art might expect that use of such a mixture would change the decorative effect achieved and, thus, be contrary to the Hawrylko objectives. In this case, the lack of motivation for one of ordinary skill in the art to modify the Hawrylko compositions is even more clear. In this context, it is pointed out that Hawrylko provides no suggestion at all that its materials could be or would be desired to be laser markable. Thus, there is no suggestion to modify Hawrylko in a manner which would lead to the objectives of applicants' invention.

Linzmeier relates to laser markable plastics and discloses thermoplastics which contain pearlescent type pigments. The combined teachings of Hawrylko and Linzmeier, considered as a whole, also fail to suggest the claimed invention to one of ordinary skill in

of identical nature and scope. Further, the distinct use of the Hawrylko materials gives no hint that they would or would be desired to be laser markable. Accordingly, applicants urge that laser markability is not a **necessary and inevitable** property of the Hawrylko materials.

For the above reasons, the rejection under 35 U.S.C. § 102 should be withdrawn.

### **The Rejection Under 35 U.S.C. § 103**

The rejection of claim 6 under 35 U.S.C. § 103, as being obvious over Hawrylko in view of Linzmeier (U.S. Patent No. 6,521,688) is respectfully traversed.

Hawrylko is discussed above and that discussion is incorporated herein by reference. As discussed, Hawrylko fails to disclose compositions having a metal powder and/or semimetal powder which comprises a mixture of silicon/aluminum or boron/aluminum. The disclosure and background discussion of Hawrylko make clear that Hawrylko is specific to the use only of aluminum as a metal powder. Apparently, the decorative effect sought by Hawrylko requires the use, solely, of aluminum powder as a metal powder. There is no suggestion in Hawrylko to use other metal or semimetal powder in admixture with aluminum powder. To the contrary, one of ordinary skill in the art might expect that use of such a mixture would change the decorative effect achieved and, thus, be contrary to the Hawrylko objectives. In this case, the lack of motivation for one of ordinary skill in the art to modify the Hawrylko compositions is even more clear. In this context, it is pointed out that Hawrylko provides no suggestion at all that its materials could be or would be desired to be laser markable. Thus, there is no suggestion to modify Hawrylko in a manner which would lead to the objectives of applicants' invention.

Linzmeier relates to laser markable plastics and discloses thermoplastics which contain pearlescent type pigments. The combined teachings of Hawrylko and Linzmeier, considered as a whole, also fail to suggest the claimed invention to one of ordinary skill in

the art. Linzmeier discloses nothing regarding use of a metal or semimetal powder in its thermoplastics. Certainly, it discloses nothing regarding a mixture of silicon/aluminum or boron/aluminum as such powder. Accordingly, Linzmeier fails to suggest to one of ordinary skill in the art modification of the Hawrylko compositions to provide a composition having such a powder mixture. Further, even if Linzmeier suggested to one of ordinary skill in the art that the Hawrylko compositions would be laser markable, such would not suggest the claimed invention because, as discussed, Hawrylko fails to suggest a composition having a powder mixture of silicon/aluminum or boron/aluminum.

For the above reasons, it is urged that the combined teachings of the prior art, taken as a whole, fail to suggest the claimed invention to one of ordinary skill in the art. Thus, the rejection under 35 U.S.C. § 103 should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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